TABLE OF CONTENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
Joshua ALLEN et al.	:	Confirmation Number: 6352
Application No.: 10/675,726	:	Group Art Unit: 2144
Filed: September 30, 2003	:	Examiner: N. Donabed

For: AUTONOMIC SLA BREACH VALUE ESTIMATION

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed December 8, 2008, wherein Appellants appeal from the Examiner's rejection of claims 1-23.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on September 30, 2003, at Reel 014570, Frame 0190.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-23 are pending and two-times rejected in this Application. It is from the multiple rejections of claims 1-23 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second and Final Office Action dated September 12, 2008 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 1 and also to independent claim 1, a service level agreement (SLA) breach value estimator is disclosed. The breach value estimator includes a communicative coupling to data 150 produced for at least one resource 140 (page 8, line 22 through page 9, line 4). The breach value estimator includes a further communicative coupling to a user interface 120 through which an SLA breach value estimate is proposed (page 9, lines 8-9). The breach value estimator 120 also includes at least one SLA breach value estimation process 180 selected from the group consisting of an aggregated process, a specific customer process, a customer resource subset process, and a predictive process (page 9, lines 5-8 and 16-18; page 10, lines 4-6; page 11, lines 1-2).

Referring to Figure 1 and also to independent claim 6, a method for estimating a service level agreement (SLA) breach value is disclosed. Resource data 150 is processed to identify an acceptable SLA breach value (page 9, lines 1-8). The acceptable SLA breach value is displayed through a user interface 120 (page 9, lines 8-9).

Referring to Figure 1 and also to independent claim 15a machine readable storage having stored thereon a computer program for estimating a service level agreement (SLA) breach value is disclosed. The computer program comprises a routine set of instructions for causing the machine to perform the following steps. Resource data 150 is processed to identify an acceptable SLA breach value (page 9, lines 1-8). The acceptable SLA breach value is displayed through a user interface 120 (page 9, lines 8-9).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-5 were rejected under 35 U.S.C. § 101;

2. Claims 1-23 were rejected under 35 U.S.C. § 102 for anticipation based upon Betge-Brezetz et al., U.S. Patent Publication No. 2005/0177629 (hereinafter Betge-Brezetz).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-5 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, claims 2-5 stand or fall together with independent claim 1.

Appellants disagree with the Examiner's assertion that the claims "is nonstatutory as it does not recite any hardware elements that enable the claimed process to realize its functionality as a computer component." Initially, Appellants note that the claim is directed to a device and not a "process," as asserted by the Examiner. Moreover, a "communicative coupling" is a device and not an abstract idea as inferred by the Examiner.

Appellants also note that the Examiner requirement that a claim must recite hardware elements to enable its functionality is not a proper statement of law. In this regard, if the Examiner still believes this statement as to law to be true, Appellants respectfully solicit the Examiner to cite to a case that explicitly makes this statement. Notwithstanding the Examiner's failure to support this assertion with any case law, attention directed to the decision of the Federal Circuit of In re Comiskey,[1] which is informative as to this issue. Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that other of the claims[2] were directed to statutory subject matter. In determining the latter, the Court stated the following:

[1] Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007).
[2] ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

> These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily recite a computer. Instead, the Court concluded that if the claims, under a broadest reasonable interpretation, could require the use of statutory subject matter (e.g., a computer, a device, a product, etc.), then the claims meet the requirements of 35 U.S.C. § 101.

As already argued, claims 1-5 already recite statutory subject matter (e.g., communicative couplings). Moreover, since the standard, as set forth by the Federal Circuit, only requires that the claims could require statutory subject matter, and since under a broadest reasonable claim construction, the claimed service level agreement breach value estimator could include hardware, claims 1-5 meet the requirements of 35 U.S.C. § 101.

The above-reproduced arguments (incorporated herein) were presented on page 8, line 10 through page 9, line 15 of the First Amendment dated June 17, 2008 (hereinafter the First Amendment). The Examiner's response to these arguments is found on page 7 of the Second Office Action and reproduced below:

> Examiner maintained the rejection to Claims 1-5 because there is no mention in the specification as to the communicative coupling being a device and not an abstract idea or software. The Examiner further asks the Applicant to point out in the specification where the communicative coupling refers to hardware.

The Examiner asserts that "there is no mention in the specification as to the communicative coupling being a device." However, the Examiner has failed to produce any evidence that the communicative coupling is "an abstract idea or software." Referring to dictionary definitions from www.m-w.com, a coupling is "a device that serves to connect the ends of adjacent parts or objects" or "a means of electric connection of two electric circuits by having a part common to

both." Thus, based upon the ordinary and customary meaning of these terms, one skilled in the art would recognize that a coupling is a device or a common part (i.e., a part is also a device). Therefore, Appellants respectfully submit that the Examiner has failed to establish that the claimed invention, as recited in claim 1, fails to meet the requirements of 35 U.S.C. § 101.

THE REJECTION OF CLAIMS 1-23 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON BETGE-BREZETZ

For convenience of the Honorable Board in addressing the rejections, claims 5-23 stand or fall together with independent claim 1; dependent claim 2 stands or falls alone; and claim 4 stands or falls tougher with dependent claim 3.

As is evident from Appellants' previously-presented comments during prosecution of the present Application and from Appellants' comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

> (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:
> ...
>
> (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's

Answer.

Appellants have compared the statement of the rejection found on pages 3-6 of the Second Office Action with the statement of the rejection found on pages 3-6 of the First Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to the arguments presented in Appellants' First Amendment is found on pages 7-9 of the Second Office Action in the section entitled "Response to Arguments."

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.[3] Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.[4]

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."[5] During patent examination, the pending claims must be "given their broadest reasonable interpretation

[3] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).
[4] See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).
[5] Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

consistent with the specification,"[6] and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.[7] Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,[8] and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.[9] This burden has not been met. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).[10]

Claim 1

Independent claim 1, in part, recites "a further communicative coupling to a user interface through which an SLA breach value estimate is proposed." On page 4 of the First Office Action, to teach the claimed "SLA breach value estimate" the Examiner identified the "network evolution planning proposal" of Betge-Brezetz. Appellants respectfully disagree.

Before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. However, the Examiner has not set forth any explicit claim construction for the claimed SLA breach value estimate. Referring to page 3

[6] In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).
[7] In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).
[8] See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).
[9] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).
[10] 37 C.F.R. § 1.104(c) provides:

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

of Appellants' disclosure, an SLA breach value is the value against which trends and violations are calculated to determine whether or not the SLA has been breached. However, the SLA breach value, as recited in claim 1, is not the current SLA breach value.[11] Instead, the SLA breach value is an estimate that is being proposed.

Referring to paragraph [0003] of Betge-Brezetz, " the expression 'predicting evolution' (or planning) refers to determining when and where it is necessary to integrate new plant (for example a router or a new card) or to increase the traffic capacity of a link." Also, referring to paragraph [0011], Betge-Brezetz teaches that "in the present context 'planning proposal' means a proposal for modification (or evolution) of the network, specifying in particular action to be taken on network plant and dates for the work to be carried out." Thus, the Examiner's alleged teaching of "network evolution planning proposal" does not identically disclose the claimed "SLA breach value estimate."

The above-reproduced arguments (incorporated herein) were previously presented on page 10, line 12 through page 11, line 20 of the First Amendment. The Examiner's response to these arguments is found in the paragraph spanning pages 7 and 8 of the Second Office Action in which the Examiner asserted the following:

> Examiner is not persuaded by Applicants arguments. Examiner points to paragraphs [0047] - [0050] of Betge-Brezetz and specifically to the section which describes the thresholds of the Service Level Agreement which are values against which violations of the SLA are identified.

The Examiner's response completely ignores Appellants' arguments. As discussed above, the claimed "SLA breach value estimate" is an *estimate* that is *being proposed*. This concept, however, is entirely absent from the teachings of Betge-Brezetz.

[11] Claim 3 refers to a separate "current SLA breach value setting."

Claim 1 further recites "at least one SLA breach value estimation process selected from the group consisting of an aggregated process, a specific customer process, a customer resource subset process, and a predictive process," and to teach these limitations, the Examiner identified paragraphs [0013]-[0015] of Betge-Brezetz. Appellants respectfully disagree with the Examiner's analysis.

As best can be understood, the Examiner's cited paragraphs refer to calculating a SLA usage predictive profile (i.e., the predicted usage). However, Appellants are unclear as to where these cited passages specifically teach the claimed at least one SLA breach value estimation process. Specifically, Appellants are unclear where Betge-Brezetz specifically teaches that a breach value is estimated. Therefore, for the reasons presented above, Appellants respectfully submit that claim 1 is not identically disclosed by Betge-Brezetz within the meaning of 35 U.S.C. § 102.

The above-reproduced arguments (incorporated herein) were previously presented on page 11, line 16 through page 12, line 7 of the First Amendment. The Examiner's response to these arguments is found on page 8 of the Second Office Action in which the Examiner asserted the following:

> Examiner is not persuaded by Applicants arguments. Examiner points to paragraphs [0047] - [0050] of Betge-Brezetz and specifically to the section which describes that the parameters of the SLA are estimated.

The "estimate" described in the Examiner's cited passage is not of a "SLA breach value." Instead, paragraph [0049] refers to estimates as to a service level agreement usage predictive

profile. However, the parameters being estimated are not disclosed as being SLA breach values. Instead, referring to paragraph [0050] these parameters are used to "[predict] customer requirements in terms of resources and/or services." This concept is also described in paragraph [0053], which describes that that predictive state (i.e., the predicted usage profile) will be used to "to determine an optimum configuration of the network from the predictive state." Paragraph [0045] refers to displaying a "planning proposal." However, the planning proposal is not comparable to the claimed estimated SLA breach value. Instead, referring to paragraph [0060], the planning proposal is a proposal for planning (or modification) of the network.

Thus, for the reasons submitted above, Appellants maintain that the Examiner has failed to establish that Betge-Brezetz identically discloses all of the claimed limitations, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Claim 2

Claim 2 recites that the estimator is disposed within an SLA builder, and to teach this limitation the Examiner cited paragraphs [0018] and [0042] of Betge-Brezetz. Upon reviewing these paragraphs, Appellants are unclear where Betge-Brezetz teaches the claimed SLA builder. Paragraph [0018] refers to a network management system and server is completely silent as to building SLAs. Although paragraph [0042] refers to generating network modification proposals, a network modification proposals is not comparable to a SLA. Thus, claim 2 further distinguishes the claimed invention over the applied prior art.

The above-reproduced arguments (incorporated herein) were previously presented on page 12, lines 15-21 of the First Amendment. The Examiner's response to these arguments is found on page 8 of the Second Office Action in which the Examiner asserted the following:

> Examiner is not persuaded by Applicants arguments. Examiner points to paragraphs [0046] - [0048] where Betge-Brezetz discusses future service level agreements that will [be] created for future customers.

Appellants are unclear if the Examiner is cognizant of the actual claim language recited in claim 2, which recites "wherein the estimator is disposed within an SLA builder." The Examiner's cited passages are completed silent as to the claimed SLA builder or that the estimator is within the SLA builder. The Examiner asserts that Betge-Brezetz "discusses future service level agreements that will [be] created for future customers." However, not only is this assertion a mischaracterization of the teachings of Betge-Brezetz, even if this assertion was true, it still fails to establish that Betge-Brezetz identically discloses the claimed limitations at issue.

Paragraph [0048] of Betge-Brezetz actually teaches that "third data consists of the future types of service level agreements likely to be entered into by the network operator," and paragraph [0046] refers to "first data supplied ... of the network and service level agreements between the network operator and its customers." However, absent from the Examiner's cited passages is any mention of a SLA builder (i.e., a device used to build a SLA). Thus, Appellants maintain that the Examiner has failed to establish that Betge-Brezetz identically discloses all of the claimed limitations, as recited in claim 2, within the meaning of 35 U.S.C. § 102.

Claim 3

Claim 3 refers to a current SLA breach value setting and a proposed SLA breach value setting, and to teach these limitations, the Examiner cited paragraphs [0017], [0045], [0048],

[0051], and [0066]-[0071]. Although paragraph [0048] refers to future types of service level agreements, this is not comparable to a proposed SLA breach value setting. The remaining cited paragraphs are also silent as to the claimed limitations at issue. Thus, claim 3 further distinguishes the claimed invention over the applied prior art.

The above-reproduced arguments (incorporated herein) were previously presented on page 13, lines 2-7 of the First Amendment. The Examiner's response to these arguments is found on page 8 of the Second Office Action in which the Examiner asserted the following:

> Examiner is not persuaded by Applicants arguments. Examiner points to paragraphs [0045] - [0051] and [0066] - [0071] and more specifically to the proposal for future service level agreements it may enter with customers in the future.

The Examiner's analysis and cited passages are still silent as to specifically identifying, within Betge-Brezetz, the alleged "SLA breach value." The fact that these paragraphs refer to future service level agreements do not inherently establish that these passages refer to a current SLA breach value setting and a proposed SLA breach value. Thus, Appellants maintain that the Examiner has failed to establish that Betge-Brezetz identically discloses all of the claimed limitations, as recited in claim 3, within the meaning of 35 U.S.C. § 102.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 101, 102 is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 8, 2008

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A service level agreement (SLA) breach value estimator comprising:

a communicative coupling to data produced for at least one resource; and,

a further communicative coupling to a user interface through which an SLA breach value estimate is proposed; and,

at least one SLA breach value estimation process selected from the group consisting of an aggregated process, a specific customer process, a customer resource subset process, and a predictive process.

2. The SLA breach value estimator of claim 1, wherein the estimator is disposed within an SLA builder.

3. The SLA breach value estimator of claim 1, further comprising a graphical user interface configured to render a chart of resource data over time derived from said produced data along with an indication of a current SLA breach value setting and a proposed SLA breach value setting.

4. The SLA breach value estimator of claim 3, wherein said proposed SLA breach value setting comprises a programmatic configuration for being graphically modified to establish a new SLA breach value setting.

5. The SLA breach value estimator of claim 1, further comprising:

a compliance process disposed within said SLA breach value estimation process, said compliance process comprising logic for proposing an SLA breach value estimate computed to render probable SLA compliance for a percentage of time equivalent to a specified compliance value; and,

a compliance interface through which said compliance value can be specified.

6. A method for estimating a service level agreement (SLA) breach value, the method comprising the steps of:

processing resource data to identify an acceptable SLA breach value; and,

displaying said acceptable SLA breach value through a user interface.

7. The method of claim 6, wherein said processing step comprises the step of identifying a best practices SLA breach value based upon resource data for an aggregation of customers.

8. The method of claim 6, wherein said processing step comprises the step of identifying an average SLA breach value for a specific customer.

9. The method of claim 8, wherein said identifying step comprises the step of identifying an average SLA breach value for a specific customer for a specific resource.

10. The method of claim 6, wherein said processing step comprises the steps of:

identifying an SLA breach value trend based upon past measured performance data; and,

predicting a future SLA breach value based upon said trend.

11. The method of claim 6, wherein said processing step further comprises the step of increasing said acceptable SLA breach value by a fixed proportion.

12. The method of claim 6, further comprising the steps of:

rendering a chart of said resource data against a period of time in a graphical user interface; and,

overlaying an indicator both of a current SLA breach value and a proposed SLA breach value about said rendered chart.

13. The method of claim 12, further comprising the steps of:

permitting the graphical manipulation of said indicator of said proposed SLA breach value; and,

establishing an SLA breach value based upon said graphical manipulation.

14. The method of claim 6, further comprising the steps of:

establishing a compliance percentage; and,

computing said acceptable SLA breach value so that SLA compliance is probable for a percentage of time equivalent to said compliance percentage.

15. A machine readable storage having stored thereon a computer program for estimating a service level agreement (SLA) breach value, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

processing resource data to identify an acceptable SLA breach value; and,

displaying said acceptable SLA breach value through a user interface.

16. The machine readable storage of claim 15, wherein said processing step comprises the step of identifying a best practices SLA breach value based upon resource data for an aggregation of customers.

17. The machine readable storage of claim 15, wherein said processing step comprises the step of identifying an average SLA breach value for a specific customer.

18. The machine readable storage of claim 17, wherein said identifying step comprises the step of identifying an average SLA breach value for a specific customer for a specific resource.

19. The machine readable storage of claim 15, wherein said processing step comprises the steps of:

identifying an SLA breach value trend based upon past measured performance data; and,

predicting a future SLA breach value based upon said trend.

20. The machine readable storage of claim 15, wherein said processing step further comprises the step of increasing said acceptable SLA breach value by a fixed proportion.

21. The machine readable storage of claim 15, further comprising the steps of:

rendering a chart of said resource data against a period of time in a graphical user interface; and,

overlaying an indicator both of a current SLA breach value and a proposed SLA breach value about said rendered chart.

22. The machine readable storage of claim 21, further comprising the steps of:

permitting the graphical manipulation of said indicator of said proposed SLA breach value; and,

establishing an SLA breach value based upon said graphical manipulation.

23. The machine readable storage of claim 15, further comprising the steps of:

establishing a compliance percentage; and,

computing said acceptable SLA breach value so that SLA compliance is probable for a percentage of time equivalent to said compliance percentage.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.